

REMARKS

In the final Office Action of January 15, 2004, the Examiner indicated dependent Claims 13 and 19 would be allowed if rewritten and rejected the remaining claims.

Interview

The Applicant thanks the Examiner for the courtesy extended during the telephone interview of April 8, 2004. It is unfortunate the supervising examiner was unavailable so that no one with signatory authority was involved in the conference. The Examiner could not explain why Kadaba discloses a barcode that identifies a customer when the text of Kadaba says that only the DIAD has the customer information. The Examiner requested arguments be submitted in writing, and indicated that even previously allowable claims would be rejected.

Claims 1-4, 14-16

Claim 1 and dependent Claims 2-4 and 14-16 define "bar code, wherein the bar code identifies the customer." The Examiner says this is identically shown in Kadaba, Col. 5, lines 56- Col. 6.

But the cited portion of Kadaba refers to Fig. 3 to describe checking in items using a personal digital assistant (PDA) in one of very two different ways. Only the first way uses a wand to scan a barcode 30 on the item and the scanned barcode does not include the recipient's identity. The second way does not use a barcode, and instead downloads tracking information into the PDA from a driver's portable data acquisition device such as a DIAD. It is only the data downloaded from the DIAD device that can include the identity of the intended recipient, not the barcode. There is thus no disclosure that Kadaba uses barcode to include the claimed information.

Reconsideration and withdrawal of the rejection of Claims 1-4 and 14-16 is thus respectfully requested.

Claim 5, 6 and 17

Claim 5 defines "updating the customer's order and return history."

The Examiner says Hauser, Figs. 1-6, abstract, col. 2, lines 9-38, col. 3, lines 43-Col. 6, line 17, updates the customers return history as cited by the Examiner.

But all that the cited portion shows is that the customer's account is credited for the returned merchandise. Crediting an account is not the same as updating the return history of the customer. See Specification at 11, lines 10-18; page 12, lines 1-5 and 21-25, page 14, lines 10-18.

The Examiner says that Markman Figs. 1-6, Col. 5, lines 62-Col. 6, line 40, Col. 8, lines 63 – Col. 9, line 19, disclose tracking a customer order history. But Markman tracks items of laundry submitted for cleaning and only for a single cleaning transaction. Markman deletes the removable tracking number and reuses it once the items are returned to the customer. There is no tracking of laundry beyond each separate transaction. There is no "history" being tracked.

As Markman and Hauser each lack a claimed element, even if Markman can be combined with Hauser the claimed combination does not exist. Reconsideration and withdrawal of the rejection is requested.

Further, Markman describes a laundry tracking system and Hauser describes a system in which store merchandise is returned to a central location for disposal. No one is going to turn their dry cleaning (Markman) in to a clearing house (Hauser) so the references are not combinable without using hindsight. The Examiner's proffered excuse for combining isolated portion of Markman and Hauser shows the use of hindsight. It does not comply with the Patent Office Requirement that the record

The Examiner must not only explain the motivation for modifying and combining references, but must point to some concrete evidence in the record supporting the motivation to modify and the motivation to combine those references.

As an administrative tribunal, the Board clearly has expertise in the subject mater over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, **the Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.** To hold otherwise would render the process of appellate review for substantial evidence on the record a

meaningless exercise. [*In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (emphasis added)].

The required evidence in the record to support the proffered combinations is entirely missing. The Examiner says the three references are combined "in order to provide a more informative system to the customer/merchant." That fails to identify a basis in the record for picking these two specific patents and combining selected portions of them together to achieve the claimed combination.

Reconsideration and withdrawal of the rejection is requested.

Claims 7-12 and 18-19.

Claim 7 and dependent Claims 7-12 and 18-19 are amended to define the step of mailing the advertising along with the item. The cited references do not disclose that. Thus, even if Denton and Westrope are combined, the claimed combination is not met.

Reconsideration and withdrawal of the rejection is requested.

Claim 20 (New)

Claim 19 was previously said to be allowable if rewritten and that claim is rewritten as new Claim 20. Allowance is respectfully requested.

Conclusion

In view of the above comments, reconsideration and withdrawal of the rejection of the claims is requested.

If any additional fee is required, please charge Deposit Account Number 19-4330.

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